

REMARKS

The preceding amendments and following remarks present a complete and timely response to the non-final Office Action mailed July 30, 2003 (Paper No. 5). Upon entry of the attached amendments, claims 1, 3-10, and 12-33 remain pending. Claims 2 and 11 have been canceled without prejudice, waiver, or disclaimer. Claims 1, 3-5, 9, 10, 12, 13, 18, 20, and 21 have been amended. Claims 27-33 have been added. The subject matter in amended claims 1, 3-5, 9, 10, 12, 13, 18, 20-26, and new claims 27-33 is included in FIGs. 2-4, 6, and 7A-7D and described in the corresponding portions of the detailed description. Consequently, no new matter is added to the present application.

Each objection and rejection presented in the non-final Office Action mailed July 30, 2003 is discussed in the following remarks.

I. Objection to the Drawings

A. Statement of the Objection

The Office Action indicates that the drawings are objected to for allegedly failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 210f as stated on page 11, line 27.

B. Discussion of the Objection

Applicants have herein amended the specification such that the reference to item 210f has been redacted. Consequently, Applicants respectfully submit that the objection to the drawings has been rendered moot and the objection should be withdrawn.

II. Objection to the Specification

A. Statement of the Objection

The Office Action indicates that the disclosure is objected to for allegedly containing the following informalities. On page 12, lines 2-3, 100f is not mentioned. On page 13, line 19 the disclosure refers to FIG. 4B. The Brief Description of the Drawings and the Figures do not include a Figure 4B.

B. Discussion of the Objection

Applicants have herein amended the specification such that the paragraph starting on p. 11, line 28, includes a description of reference 100f. Applicants have also amended the specification such that the reference to FIG. 4B has been changed to FIG. 4. Consequently, Applicants respectfully submit that the objections to the specification have been rendered moot and the objections should be withdrawn.

III. Claim Rejections Under 35 U.S.C. § 112 - Claims 1-13 and 18-26

A. Statement of the Objection

Claims 1-13 and 18-26 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention.

Specifically, the statement of the rejection in the Office Action alleges that there is insufficient antecedent basis for the limitation “modified boot memory” in claims 1-8, 10-13, and 18-26.

Regarding claims 4, 18, and 21, the statement of the rejection in the Office Action alleges that there is insufficient antecedent basis for the limitation “the new firmware.”

Regarding claims 9-13, the statement of the rejection in the Office Action alleges that there is insufficient antecedent basis for the limitation “modified boot memory map.”

B. Discussion of the Rejection - Claims 1-13 and 18-26

Applicants have herein amended claims 1, 4, 9, 10, and 18 to provide the requisite antecedent basis for all claim elements and limitations. Specifically, claim 1 has been amended to recite “a boot memory.” Claim 4 has been amended to recite “a new firmware.” Claim 9 has been amended to recite “a patch memory map.” Claim 10 has been amended to recite “a patch memory.” Claim 18 has been amended to recite “a boot image.” Consequently, Applicants respectfully submit that the rejection of claims 1-13 and 18-26 has been overcome and the rejection should be withdrawn.

IV. Claim Rejections Under 35 U.S.C. § 102 - Claims 1, 9, 10, and 13

A. Statement of the Rejection

Claims 1, 9, 10, and 13 presently stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 5,859, 911 to Angelo *et al.*, hereafter *Angelo*.

B. Discussion of the Rejection - Claims 1, 9, 10, and 13

Applicants respectfully traverse the rejection of amended claims 1, 9, 10, and 13. A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See *e.g.*, *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129. (Fed. Cir. 1988.)

Applicants traverse the rejection of amended claims 1, 9, 10, and 13 for at least the reason that *Angelo* fails to disclose, teach, or suggest each element and/or method step in the claims. Claim 1 is exemplary. Claim 1, as amended, recites a boot memory comprising a system loader, a configuration file, and executable files. The statement of the rejection concerning originally filed claim 2 admits that *Angelo et al.* do not teach directing a system loader to instruct a microprocessor to load a firmware upgrade patch. (Office Action, Paper No. 5, page 7, item 16.) Accordingly, claim 1, as amended is allowable over the cited art of record.

Claim 9, as amended, recites a firmware upgrade patch comprising a bootable kernel. The statement of the rejection concerning originally filed claim 6 admits that *Angelo et al.* do not disclose that the flash application comprises a bootable kernel. (Office Action, Paper No. 5, page 9, regarding claim 6.) Accordingly, claim 9, as amended is allowable over the cited art of record.

Claim 10, as amended, depends from allowable claim 9 and is also allowable for at least the reason that claim 10 includes all the elements and limitations of independent claim 9. Claim 10 further recites a patch memory map. *Angelo et al.* do not disclose a patch memory map. For at least this separate and additional reason, claim 10, as amended, is allowable over the cited art of record.

Claim 13, as amended, depends from allowable claim 9 and is also allowable for at least the reason that claim 13 includes all the elements and limitations of independent claim 9. Claim 13 further recites a file management system. *Angelo et al.* do not disclose a file management system. For at least this separate and additional reason, claim 13, as amended, is allowable over the cited art of record.

In summary, Applicants' amended claims 1, 9, 10, and 13 recite elements not disclosed in *Angelo*. Consequently, Applicants respectfully submit that the rejection of claims 1, 9, 10, and 13 should be withdrawn.

V. Claim Rejections Under 35 U.S.C. § 103 - Claims 2-8, 11, 12, 14-20 and 22-26

A. Statement of the Rejection

Claims 2-8, 11, 12, and 14-17 presently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Angelo et al.* in view of U.S. Patent 6,266,809 to Craig *et al.*, hereafter *Craig*. Claims 18-20 and 22-26 presently stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Craig* in view of *Angelo* in further view of U.S. Patent 6,324,692 to Fiske, hereafter *Fiske*.

B. Discussion of the Rejection - Claims 2-8, 11, 12, and 14-17

Claims 2 and 11 have been canceled without prejudice, waiver, or disclaimer. Consequently, Applicants respectfully submit that the rejection of claims 2 and 11 is rendered moot.

Applicants traverse the rejection of claims 3-8, 12, and 14-17 for at least the reason that the proposed combination of *Angelo* in view of *Craig* is improper. In order to make a proper *prima facie* case of obviousness; three basic criteria must be met, as set forth in MPEP 706.02(j). First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure.

It is well-established law that, in order to properly combine select elements from differing prior art sources, there must be some teaching or suggestion *within the prior art* to make the combination specifically claimed by the Appellant's invention. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." *Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's*

disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.”

(Emphasis added) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

It has often been noted that, “[h]umans must work with old elements, most if not all of which will normally be found somewhere in an examination of the prior art.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 U.S.P.Q. 193 (Fed. Cir. 1983). Furthermore, that features, even distinguishing features, are “disclosed” in the prior art is alone insufficient. As indicated above, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Id.*

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest **both** the combination of elements **and** the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements.

Applicants respectfully submit that *Craig* teaches away from Applicants’ claim 1, which recites at least one fixed storage device operatively coupled to the at least one microprocessor, wherein the at least one fixed storage device receives and stores a boot memory. *Craig* apparently describes a system and method for updating firmware in a network computer. A network computer, as defined in *Craig*, is a “diskless computer” because it does not include persistent storage such as a floppy disk, hard disk, or CD-ROM. A network computer, as described in *Craig*, contains a limited amount of volatile storage to temporarily store applications and data while the network computer is running. This volatile storage loses its information when the network computer is turned off. *Craig* describes that a limited amount of non-volatile storage may be provided to store a security key and a URL to identify the server with which the network computer works.

(See *Craig*, column 2, lines 3-24.) In other words, the system and method apparently disclosed in *Craig* teaches away from Applicants' claimed invention because *Craig* teaches away from using "a fixed storage device to receive and store a boot memory."

Applicants' independent claim 9, as amended, recites "a fixed storage device containing a boot image having appropriate instruction code suited to transition the respective workstation to an operational mode." Consequently, *Craig* teaches away from Applicants' claim 9 because *Craig* teaches away from the claimed fixed storage device.

Applicants' independent claim 14 recites "new data to be stored and a bootable kernel are stored on a fixed memory device within the workstation in response to the remote input." Consequently, *Craig* teaches away from Applicants' claim 14 because *Craig* teaches away from the claimed fixed memory device within the workstation.

Applicants' independent claim 18, as amended, recites "delivering a firmware install patch containing a boot image to a boot disk within a plurality of networked workstations." Consequently, *Craig* teaches away from Applicants' claim 18 because *Craig* teaches away from the claimed "delivering to a boot disk . . . within a plurality of workstations."

The mere fact that a reference teaches away from the combination with another reference is sufficient to defeat an obviousness claim. See *Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383. Therefore, Applicants respectfully submit that the Office Action has failed to establish a proper motivation or suggestion to combine the teachings of *Angelo* in view of the teachings of *Craig* such as to render obvious Applicants' claims 3-8, 12, and 14-17. Accordingly, the rejection of claims 3-8, 12, and 14-17 should be withdrawn.

C. Discussion of the Rejection - Claims 18-20 and 22-26


Applicants traverse the rejection of claims 18-20 and 22-26 for at least the reason that the proposed combination of *Craig* in view of *Angelo* in further view of *Fiske* is improper. As shown above, *Craig* teaches away from Applicants' independent claims 1, 9, 14, and 18. Accordingly, the Office Action has failed to establish a proper motivation or suggestion to combine the teachings of *Craig* in view of *Angelo* in further view of *Fiske* such as to render obvious Applicants' claims 18-20 and 22-26. Accordingly, the rejection of claims 18-20 and 22-26 should be withdrawn.

CONCLUSION

In summary, Applicants' claims 1, 3-10, and 12-33 are allowable over the cited art of record and the present application is in condition for allowance. Accordingly, a Notice of Allowance is respectfully solicited. Should the Examiner have any comments regarding the Applicants' response, Applicants request that the Examiner telephone Applicants' undersigned attorney.

Respectfully submitted,

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